



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,508	04/09/2001	Jack G. Winterowd	WEYE117204	6724
26389	7590	09/23/2004	EXAMINER	
CHRISTENSEN, O'CONNOR, JOHNSON, KINDNESS, PLLC			SHOSHO, CALLIE E	
1420 FIFTH AVENUE			ART UNIT	
SUITE 2800			PAPER NUMBER	
SEATTLE, WA 98101-2347			1714	

DATE MAILED: 09/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/829,508

Applicant(s)

WINTEROWD, JACK G.

Examiner

Callie E. Shosho

Art Unit

1714

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 26 August 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): 35 USC 103 rejections of record.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 1,3-6,9-13,15-22,24,26-28,33.

Claim(s) objected to: _____.

Claim(s) rejected: 2 and 25.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Callie E. Shosho
Primary Examiner
Art Unit: 1714

Attachment to Advisory Action

1. Applicant's amendment and arguments filed 8/26/04 have been fully considered but are not persuasive with respect to the rejection of record against claim 2 and claim 25 under 35 USC 112, 2nd paragraph.

Applicant's amendment filed 8/26/04 overcomes the 35 USC 103 rejections of record. Thus, the only remaining rejection is the rejection of claims 2 and 25 under 35 USC 112, 2nd paragraph.

In the office action mailed 6/29/04, the examiner argued that the scope of each of claim 2, which depends on claim 1, and claim 25, which depends on claim 24, was confusing because it was not clear how the paint can further "comprise" additional ingredients including those which would effect the basic and novel characteristics of the paint when the scope of the paint has already been limited to "consisting essentially of" as set forth in either claim 1 or claim 24.

In response, in the amendment filed 8/26/04, applicants argue that the various ingredients recited in each of claims 2 and 25, i.e. preservative, optical brightener, plasticizer, dispersing aid, coalescing aid, and defoaming agent are not ingredients that materially affect the basic and novel characteristics of the claimed paint composition. Applicant further argues that these ingredients are merely additives that are well known and commonly employed in paints and thus, do not materially affect the basic and novel characteristics of the claimed paint.

However, while applicant states that the various ingredients recited in either claim 2 or claim 25 do not materially affect the basic and novel characteristics of the claimed paint, applicant has provided no evidence to support this position. That is, applicant has merely provided a conclusionary statement with no evidence to support such statement. Further, it is

noted that “the arguments of counsel cannot take the place of evidence in the record”, *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965).

Additionally, while preservative, optical brightener, plasticizer, dispersing aid, coalescing aid, and defoaming agent may be additives commonly used in paint compositions, this does not also necessarily mean that these ingredients do not affect the basic and novel characteristics of the paint. That is, an additive commonly used in paints could also affect the basic and novel characteristics of such paint.

Further, the scope of each of claims 2 and 25 is confusing because it is not clear how the paint can further “comprise” additional ingredients given that each of claims 1 and 24, on which claims 2 and 25 depend respectively, is already limited to “consisting essentially of” transitional language. Even if the applicant were to provide evidence that the preservative, optical brightener, plasticizer, dispersing aid, coalescing aid, and defoaming agent do not affect the basic and novel characteristics of the paint, the use of the word “comprising” in both claim 2 and claim 25 opens the scope of these claims to other ingredients in addition to those explicitly recited. That is, the open language of claim 2 or claim 25, i.e. “comprising”, appears to open the claim to any type of additional ingredients and thus fails to properly further limit the scope of each of claim 2 and claim 25 in light of the “consisting essentially of” transitional language used in each of claim 1 and claim 24.

NOTE: If claim 2 and claim 25 were each rewritten in independent form, i.e. water based paint composition consisting essentially of the specific ingredients (a), (b), (c), (d) and (e) recited in either claim 1 or claim 24 “and (f) at least one of a preservative, an optical brightener, a

Art Unit: 1714

plasticizer, a dispersing aid, a coalescing aid, or a defoaming agent”, the 35 USC 112, 2nd paragraph rejection against each of claim 2 and claim 25 would be overcome.



Callie E. Shosho
Primary Examiner
Art Unit 1714

CS
9/16/04